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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|----------------------|------------------|
| 10/774,119 | 02/06/2004 | Albert S. Deutsch | PISCES 00.01 CIP DIV | 8413 |
| 27667 | 7590 | 08/15/2005 | EXAMINER | |
| HAYES, SOLOWAY P.C. 130 W. CUSHING STREET TUCSON, AZ 85701 | | | ZIMMERMAN, JOSHUA D | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2854 | |

DATE MAILED: 08/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|---------------------------------|--------------------------------|--|
| Office Action Summary | Application No. 10/774,119 | Applicant(s) DEUTSCH ET AL. | |
| | Examiner Joshua D. Zimmerman | Art Unit 2854 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) 1-8, 14, 15, 17, 18 and 23-28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9-13, 16, 19-22, 29 and 30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>3-31-2005, 5-6-2005</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement filed February 6, 2004 fails to comply with 37 CFR 1.98(a)(1), which requires the following: (1) a list of all patents, publications, applications, or other information submitted for consideration by the Office; (2) U.S. patents and U.S. patent application publications listed in a section separately from citations of other documents; (3) the application number of the application in which the information disclosure statement is being submitted on each page of the list; (4) a column that provides a blank space next to each document to be considered, for the examiner's initials; and (5) a heading that clearly indicates that the list is an information disclosure statement. The information disclosure statement has been placed in the application file, but the information referred to therein has not been considered.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 9-13, 16, 19, 20, and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by US 6,187,380 Hallman et al.

1. Regarding claim 16, Hallman et al. teach "a method of imaging a lithographic printing plate having a coating comprising monomers and a photoinitiator, comprising

the step of: applying imagewise a co-synergist" (Column 10, line 59 – column 11, line 6).

2. Regarding claim 19, Hallman et al. teach "a process for preparing for press a printing plate having a coating comprising epoxy resins, comprising the step of: applying imagewise to said coating, a solution comprising an amine" (Column 11, lines 1-6 and column 6, lines 5-10).

3. Regarding claim 20, Hallman et al. teach "a computer to plate system, comprising: (a) a print head containing a plurality of ink jet nozzles such that the print head is capable of jetting imagewise a solution, (figure 1 and column 10, lines 50-51) (b) a printing plate having a coated surface comprising photosensitive compounds capable of being insolubilized by the solution, (c) a heater capable of heating the printing plate, and (c) a developer capable of dissolving the non-imaged coating" (column 11 lines 1-6, examples 1-3).

4. Regarding claim 21, Hallman et al. teach "a computer to plate system, comprising: (a) an ink jet printer with a print head capable of imaging printing plates, (figure 1 and column 10, lines 50-51) (b) an ink capable of insolubilizing a coating containing reaction products of photosensitive compounds, (column 4, lines 40-63) (c) a printing plate having a coating comprising of reaction products of presensitized photosensitive coating (column 7 lines 55-63).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 9-13, 22, and 29-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hallman et al. (US 6,187,380) in view of DeBoer et al. (US 6,044,762).

5. Regarding claim 9, Hallman et al. teach a method of "develop(ing) a lithographic printing plate having a subtractive coating, comprising the step of: a) imagewise applying an insolubilizing chemical to said coating" (column 6, lines 50-53). Hallman et al. lack the "method of using a printing press employing working fluids in normal operation" which comprises "b) mounting said plate on said printing press; and c) operating said printing press such that the unimaged areas of the coating are dissolved in the working fluids." DeBoer et al. teach an on-press system which uses said "working fluids in normal operation ... such that the unimaged areas of the coating are dissolved in the working fluids" (column 5, lines 17-26). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the system and process of

Hallman et al. with the on-press developing system of DeBoer et al. so as to quickly and efficiently prepare the printing plate for printing.

6. Regarding claim 10, Hallman et al. further teach "wherein said coating comprises acrylate monomers" (column 6, lines 11-22).

7. Regarding claim 11, Hallman et al. further teach "wherein said coating also comprises photoinitiators" (column 4, lines 53-63).

8. Regarding claim 12, Hallman et al. further teach "wherein the insolubilizing chemical comprises amine functional groups" (column 6, lines 5-10).

9. Regarding claim 13, Hallman et al. further teach "wherein the insolubilizing chemical is selected from the group consisting of: amine salts, amines, or bases" (column 6, lines 5-10).

10. Regarding claim 29, Hallman et al. teach a computer-to-plate system comprising an "ink jet printhead containing an insolubilizing fluid" (figure 1 and column 11, lines 1-6). Hallman et al. lack integrating said computer-to-plate system into a printing press for a "computer-to-press system." DeBoer et al. teach "a computer-to-press system, comprising: a) a printing press" and "an on-press developable printing plate." It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the system and process of Hallman et al. with the on-press developing system of DeBoer et al. so as to quickly and efficiently prepare a printing plate for printing.

11. Regarding claim 30, Hallman et al. further teach "wherein said insolubilizing fluid comprises an amine" (column 6, lines 5-10).

12. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hallman et al. in view of Busman et al. (US 5,763,134). Hallman et al. teach "a computer to plate system." Hallman et al. lack "wherein said coating contains sulfonic acid esters or amides of carboxylic acids." Busman et al. teach that the use of "sulfonic acid esters" as photochemical progenitors for coatings on printing plates are well known in the art. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system of Hallman et al. with the coating of Busman et al. because of the wide usage of said coating in the art, allowing for an economical and readily available coating. It should also be noted that applicant admits the use of "sulfonic acid esters" and "amides" in photosensitive compositions used in positive lithographic plates is well known (page 2, lines 21-22).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua D. Zimmerman whose telephone number is 571-272-2749. The examiner can normally be reached on M-F 8:00AM - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Gray can be reached on 571-272-2119. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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jdz

A handwritten signature in black ink, appearing to read 'David Gray', with a long horizontal line extending to the right.

David Gray
Primary Examiner